

### **REMARKS**

Applicant has received the Office Action dated on September 10, 2004, and the references cited therewith.

Claims 15-17 are currently amended. Claims 1-29 are pending in this application. The amendments to the claims are supported in the specification and drawings as originally filed. No new matter has been added.

#### **Information Disclosure Statement**

Applicant submitted a Supplemental Information Disclosure Statement and a 1449 Form on April 5, 2004. Applicant respectfully requests that initialed copies of the 1449 Forms be returned to Applicant's Representatives to indicate that the cited references have been considered by the Examiner.

#### **§102 Rejection of the Claims**

Claims 24, 26, 28 and 29 were rejected under 35 USC § 102(b) as being anticipated by Comte (U.S. Patent No. 4,640,983). Applicant respectfully traverses this rejection.

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference." In re Bond, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Comte fails to disclose "providing a second conductor . . . having a second outer filar diameter surrounded by an insulative coating" as required by claim 24. In contrast, Comte merely suggests "it would be possible to provide each conductor with a flexible sheathing which holds together the wires belonging to the conductor in such a way that they contact one another more or less but are still movable somewhat with respect to one another." Comte col. 10, lines 48-52. Comte's discussion of a sheathing does not anticipate Applicant's recitation of a coating in claim 24. The discussion in Comte fails to identically establish the insulative coating as recited in claim 24. Comte also fails to identically describe that the "flexible sheathing" is insulative. Reconsideration and withdrawal of the rejection of claim 1 under § 102 is respectfully requested.

§103 Rejection of the Claims

Claims 1-9, 11-14, 18-20, 22 and 25 were rejected under 35 USC § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Helland et al. (U.S. Patent No. 5,545,201). Applicant respectfully traverses this rejection.

To support a rejection under § 103, the references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Comte and Helland alone or in combination do not teach or suggest all elements of the claims.

Claim 1

Comte and Helland neither alone nor in combination disclose each limitation of claim 1. For example, neither Comte nor Helland describe an “an insulative coating surrounding the outer filar surface.” Comte describes a sheathing, not a coating. Comte col. 10, lines 48-52 (“[I]t would be possible to provide each conductor with a flexible sheathing which holds together the wires belonging to the conductor. . . .”) Moreover, the sheathing described by Comte is not described to be insulative.

Helland and Comte also provide no motivation for providing an insulative coating around an outer filar diameter, because Comte already provides an insulative sheathing 87 between the inner spiral 85 and outer spiral 75, and Helland already provides an insulator 64 between the first and second coaxial helical conductors 60, 62. See Comte Fig. 8 and col. 9, lines 59-65, and Helland Fig. 4 and col. 3, lines 4-6.

In addition, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action stated “It would have been obvious to one having ordinary skill in the art at the time of the invention to have used an extendable/retractable electrode coupled to the second conductor, the electrode rotated by the means for facilitating rotation/ conductive plug in the Conte system in order to accurately sense and stimulate the heart so there is accurate discrimination of the cardiac rhythm enabling effective therapy to be offered to the patient.” (Office Action, p. 3.) Applicant notes that the

Office Action fails to provide full objective support for this assertion, as required by Lee. The statement is therefore based at least in part on subjective belief. Furthermore, Applicant timely traverses the assertion under § 2144 and requests that a reference supporting the assertion be provided. Applicant submits that a legally sufficient motivation to combine the references has not been established.

Reconsideration and withdrawal of the rejection of claim 1 under § 103 is respectfully requested.

#### Claim 11

Comte and Helland neither alone nor in combination disclose each limitation of claim 11. For example, neither Comte nor Helland teach or suggest an insulative coating surrounding an outer filar surface of one or more filars of the first conductor or second conductor. Comte describes a sheathing, not a coating, and does not describe the sheathing to be insulative. Comte col. 10, lines 48-56. Helland fails to remedy the deficiencies of Comte.

Moreover, Comte and Helland provide no motivation to add an insulative coating to the second conductor, because both Comte and Helland show an insulative sheath between the inner and outer conductors. See Comte Fig. 8 and col. 9, lines 59-65 and Helland Fig. 4 and col. 3, lines 4-6. Applicant also notes that the Office Action fails to provide full objective support for the asserted motivation to combine the references, as required by Lee, and as further described above. Applicant submits that a legally sufficient motivation to combine the references has not been established.

Reconsideration and withdrawal of the rejection of claim 11 over Comte and Helland is respectfully requested.

#### Claim 18

Comte and Helland neither alone nor in combination disclose each limitation of claim 18. For instance, claim 18 recites “providing insulation surrounding the second outer filar diameter such that a cross-section of the outer filar diameter is surrounded by an insulative coating,” which cannot be found in either of the cited references. Comte describes a sheathing, not a coating, and does not describe the sheathing to be insulative. Comte col. 10, lines 48-56.

Helland fails to remedy the deficiencies of Comte. Moreover, Comte and Helland provide no motivation to add an insulative coating to the second conductor, because both Comte and Helland show an insulative sheath between the inner and outer conductors. See Helland Fig. 4 and col. 3, lines 4-6 and Comte Fig. 8 and col. 9, lines 59-65. Applicant also reserves the right to traverse unsupported assertions in the office action under § 2144.

Reconsideration and withdrawal of the rejection of claim 18 over Comte and Helland is respectfully requested.

#### Claims 2-9, 12-14, 19-20, 22, and 25

Claims 2-9, 12-14, 19-20, 22, and 25 are allowable at least because they depend from an allowable independent claim. MPEP § 2143.03. As described above, Comte describes a sheathing, not a coating, and does not describe the sheathing to be insulative. Comte col. 10, lines 48-56. Moreover, neither Comte nor Helland provide a motivation to add an insulative coating to a conductor, because both Comte and Helland show an insulative sheath between the inner and outer conductors. See Helland Fig. 4 and col. 3, lines 4-6 and Comte Fig. 8 and col. 9, lines 59-65. Applicant also reserves the right to traverse unsupported assertions on pp. 2-3 in the office action under § 2144.

Reconsideration and withdrawal of the rejections of claims 2-9, 12-14, 19-20, 22, and 25 is respectfully requested.

#### Claims 10 and 15-17

Claims 10 and 15-17 were rejected under 35 USC § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Helland et al. (U.S. Patent No. 5,545,201) and further in view of Doan (U.S. Patent No. 5,425,755) and further in view of Altman (U.S. Patent No. 5,845,396).

Applicant respectfully traverses these rejections. Dependent claims 10 and 15-17 are allowable at least because they depend from an allowable independent claim. MPEP § 2143.03. As described above, Comte and Helland fail to establish all of the elements of the claims and provide no motivation to add an insulative coating to a conductor, because both Comte and

Helland show an insulative sheath between the inner and outer conductors. See Helland Fig. 4 and col. 3, lines 4-6 and Comte Fig. 8 and col. 9, lines 59-65.

Moreover, the Office Action does not supply an objective motivation to combine the references. According to the Office Action, "It would have been obvious to one having ordinary skill in the art at the time of the invention to have used an insulative coating of ETFE in the modified Conte System in order to reduce the coefficient of friction between the outer coil and outer insulation so the lead has increased flexibility facilitating the positioning and fixation in the heart, and so the torque associated with the inner coil and tubing is reduced when the helix electrode is extended or retracted to minimize damage to the lead." (Office Action, p. 3-4.) Applicant notes that the Office Action fails to provide full objective support for this assertion, as required by Lee. Furthermore, Applicant timely traverses the assertion under § 2144 and requests that a proper reference be provided. Applicant submits that a legally sufficient motivation to combine the references has not been established.

Reconsideration and withdrawal of these rejections is respectfully requested.

#### Claims 21 and 23

Claims 21 and 23 were rejected under 35 USC § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Helland et al. (U.S. Patent No. 5,545,201) and further in view of Altman (U.S. Patent No. 5,845,396).

Applicant respectfully traverses these rejections. Dependent claims 21 and 23 are allowable at least because they depend from an allowable independent claim. MPEP § 2143.03. As described above, Comte and Helland fail to establish all of the elements of the claims and provide no motivation to add an insulative coating to a conductor, because both Comte and Helland show an insulative sheath between the inner and outer conductors. See Helland Fig. 4 and col. 3, lines 4-6 and Comte Fig. 8 and col. 9, lines 59-65.

In addition, the Office Action does not supply an objective motivation to combine the references. According to the Office Action, "It would be an obvious design choice to fashion the insulation by substituting one known lead insulating material for another as a mere substitution of known functional equivalents in order to effectively insulate the conductors so electrical signals associated with the heart can be accurately sensed and delivered." Regarding claim 23,

the Office Action also stated “It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a heat-shrunken PTFE/ETFE insulated conductors in the modified Comte et al. system in order to have the design flexibility to create leads that have more conductors and smaller diameters than traditional leads.” Applicant notes that the Office Action fails to provide full objective support for these assertions, as required by Lee. Furthermore, Applicant timely traverses the assertion under § 2144 and requests that a proper reference be provided. Applicant submits that a legally sufficient motivation to combine the references has not been established.

Reconsideration and withdrawal of these rejections is respectfully requested.

#### Claim 27

Claim 27 was rejected under 35 USC § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Altman (U.S. Patent No. 5,845,396). Applicant respectfully traverses this rejection. Dependent claim 27 is allowable at least because it depends from an allowable independent claim. MPEP § 2143.03. As described above, Comte fails to establish all of the elements of the claims.

The rejection also fails because there is no legally sufficient motivation to selectively combine the references. According to the Office Action, “It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a heat-shrunken PTFE/ETFE insulated conductors in the Comte system in order to have the design flexibility to create leads that have more conductors and smaller diameters than traditional leads.” Applicant notes that the Office Action fails to provide full objective support for this assertion, as required by Lee. Furthermore, Applicant timely traverses the assertion under § 2144 and requests that a proper reference be provided. Applicant submits that a legally sufficient motivation to combine the references has not been established.

Reconsideration and withdrawal of these rejections is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6913 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date December 10, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10<sup>th</sup> day of December, 2004.

JEFFREY P. Cook

Name

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